

REMARKS

By this Amendment, Applicants amend claims 1-9 and 12-16. Claims 1-9 and 12-16 are currently pending.

In the final Office Action mailed on July 22, 2004, the Examiner rejected claims 1, 2, 6, 7, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,910,120 to Jarett et al. (hereinafter "Jarett") in view of U.S. Patent No. 5,943,333 to Whinnett et al. (hereinafter "Whinnett"); rejected claims 3, 8, 9, and 14 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Whinnett and further in view of U.S. Patent No. 6,175,620 to Rouge et al. (hereinafter "Rouge"); and rejected claims 4, 5, 15, and 16 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Whinnett and further in view of U.S. Patent No. 6,449,484 to Grubeck et al. (hereinafter "Grubeck"). Applicants respectfully traverse the Examiner's rejection under 35 U.S.C. § 103.

Applicants respectfully traverse the Examiner's rejection of claims 1, 2, 6, 7, 12, and 13 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Whinnett. In order to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Third, there must be a reasonable expectation of success. See M.P.E.P. § 2143.

Claim 1, as amended, recites a combination including, for example, "means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second

radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively.” Jarett fails to teach or suggest at least “means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively,” as required by amended claim 1.

Jarett discloses a wireless communication system that “has a base station that is connected to a landline of a public switched telephone network.” “The base station has a transceiver, which has first and second channels.” Jarett, column 3, lines 62-66. “The system has a first regional cellular network compatible mobile station . . . , and a second regional cellular network compatible mobile station.” “The first and second mobile stations establish a communication link with each other through the base station without using the landline or the regional cellular network.” Jarett, column 3, line 66 to column 4, line 9, emphasis added. However, Jarett’s teaching of communication link between the first and second mobile stations does not constitute a teaching of “means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively,” as required by amended claim 1 (emphasis added).

Whinnett fails to cure Jarett's deficiencies. Whinnett discloses a dual-mode communication device, where a "controller 150, typically a microcontroller, is coupled to control the first and second mode blocks 130 and 140, . . . the first mode block 130, if selected by the controller, provides a first mode of operation of the terminal such that communication takes place with the first network 40 . . . , the second mode block 140, if selected by the controller, provides a second mode of operation of the terminal such that communication takes place with the second network 50." Whinnett, column 3, lines 26-35. "If the optimal network is not the currently registered one, . . . , then the terminal 100 will seek to handoff to the second network 50." Whinnett, column 4, lines 26-29, emphasis added. However, Whinnett's teaching of making communication via an optimal network does not constitute a teaching of "means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively," as required by amended claim 1 (emphasis added).

Therefore, neither Jarett nor Whinnett, taken alone or in any reasonable combination, teaches or suggests all elements of Applicants' invention as recited in amended claim 1. Accordingly, Applicants respectfully request withdrawal of the rejection of claim 1. Since claim 2 depends on claim 1, Applicants also request withdrawal of claim 2 for at least the reasons stated above.

Independent claims 6 and 12, while of different scope, recite language similar to that of claim 1, claims 2 and 6 are therefore allowable for at least the same reasons stated above. Applicants respectfully request withdrawal of the rejection of claims 6 and 12. Applicants also request withdrawal of the rejection of claims 7 and 13 because claims 7 and 13 depend on claims 6 and 12, respectively.

Applicants also respectfully traverse the Examiner's rejection of claims 3, 8, 9, and 14 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Whinnett and Rouge. Claim 3 depends on claim 1. As explained above, Jarett and Whinnett fails to teach or suggest at least "means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively," as recited in claim 1.

Rouge fails to cure Jarett and Whinnett's deficiencies. Rouge discloses "[a] telephone service using a server designated by a telephone number and connected to a telephone network." Rouge, abstract. "A telephone number of the server is replaced in a request to set up the second call with the stored telephone number of the calling terminal in response to the request to set up the first call in the server." Rouge, abstract. However, Rouge does not teach or suggest "means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to

selectively make simultaneous communication with the base station and the second communication terminal, respectively,” as required by amended claim 1 (emphasis added).

Therefore, none of Jarett, Whinnett, and Rouge, taken alone or in any reasonable combination, teaches or suggests all elements of Applicants’ invention as recited in amended claim 1. Since claim 3 depends on claim 1, Applicants respectfully request withdrawal of the rejection of claim 3 for at least the reasons stated above.

Independent claims 6 and 12, while of different scope, recite language similar to that of claim 1, Jarett, Whinnett, and Rouge therefore also fail to suggest or teach all elements of claims 6 and 12. Since claims 8 and 9 depend on claim 6, and claim 14 depends on claim 12, Applicants respectfully request withdrawal of claims 8, 9, and 14 for at least the reasons stated above as regard to claim 1.

Applicants also respectfully traverse the Examiner’s rejection of claims 4, 5, 15, and 16 under 35 U.S.C. § 103(a) as unpatentable over Jarett in view of Whinnett and Grubeck. Claims 4 and 5 depend on claim 1. Grubeck, as well, fails to cure Jarett and Whinnett’s deficiencies on suggesting or teaching “means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively,” as recited in claim 1.

Grubeck discloses a method for “assignment of mobile stations (MS1-MS-4) to so called multi-user channels (CH1, CH2) in a radio communication system.” Grubeck,

abstract. "All of the mobile stations MS1-MS-4 are assumed to be located within the area covered by the base station BS" and each mobile station indicates "its power requirement P from the base station BS." Grubeck, column 5, lines 36-45. However, Grubeck does not teach or suggest at least "means for connecting the first radio channel and the second radio channel, such that a communication channel between the first communication terminal and the second communication terminal can be established, wherein the first radio unit and the second radio unit are configured to selectively make simultaneous communication with the base station and the second communication terminal, respectively," as recited in claim 1.

Therefore, none of Jarett, Whinnett, and Grubeck, taken alone or in any reasonable combination, teaches or suggests all elements of Applicants' invention as recited in amended claim 1. Since claims 4 and 5 depend on claim 1, Applicants respectfully request withdrawal of the rejection of claims 4 and 5 for at least the reasons stated above.

Independent claim 12, while of different scope, recites language similar to that of claim 1, Jarett, Whinnett, and Grubeck therefore also fail to teach or suggest all elements of claim 12. Since claims 15 and 16 depend on claim 12, Applicants respectfully request withdrawal of claims 15 and 16 for at least the reasons stated above as regard to claim 1.


In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: February 24, 2005

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